

### **REMARKS**

The above-identified application has been considered in view of the Final Office Action that was mailed on May 12, 2009. Claims 5-9, 11, 13, 17, and 20-31 are currently pending. By the present Preliminary Amendment, Applicants have amended the written description and the drawings, amended claims 5 and 13, canceled claims 10, 12, and 19, and added new claims 21-31 for consideration. Applicants respectfully submit that these amendments are fully supported by the specification, and do not introduce any new subject matter. In view of the following remarks and arguments, Applicants respectfully submit that claims 5-9, 11, 13, 17, and 20-31 are allowable over the references of record, and accordingly, respectfully request allowance of these claims.

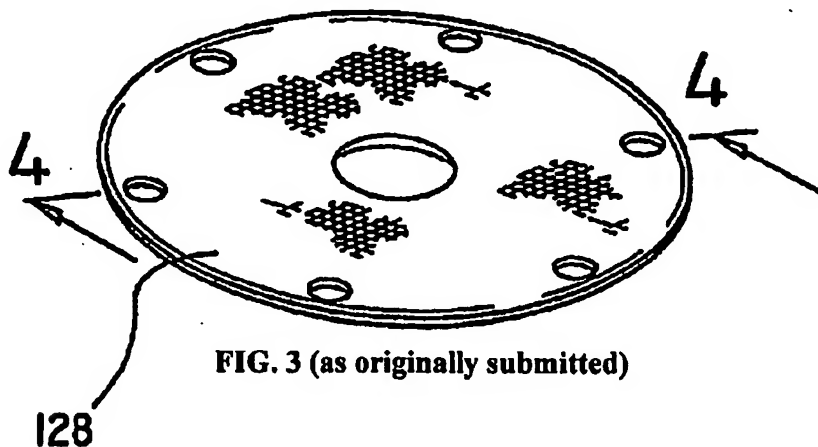
In the Final Office Action, claim 10 was objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. As indicated above, claim 10 has been canceled. Accordingly, Applicants respectfully request withdrawal of the objection to claim 10.

Claims 9 and 20 were rejected under 35 U.S.C. §112, first paragraph, for failure to comply with the written description requirement. Specifically, with respect to claim 9, it was asserted that the specification fails to support the recitation of resilient material "disposed within interstices defined by the fabric such that the resilient material is at least partially formed with the fabric in an integral manner," and with respect to claim 20, it was asserted that the specification fails to support the recitation of a sealing member that is "non inflatable."

Regarding the rejection of claim 9, Applicants have amended the written description herein to provide literal support for subject matter illustrated in FIG. 3 as originally submitted, and recited in claim 9. Specifically, Applicants have amended the written description

to state that the “[f]abric portion 128 includes a plurality of interwoven strands 129 (FIG. 3) defining interstices 129a.” Additionally, Applicants have amended FIG. 3 to identify the strands 129 and the interstices 129a defined thereby.

Since the strands 129 and the interstices 129a can clearly be seen in the version of FIG. 3 that was originally filed (reproduced below), Applicants respectfully submit that the amendments to the written description and the drawings effectuated herein do not introduce any new subject matter. And in view of these amendments, Applicants respectfully submit that the specification fully supports the subject matter recited in claim 9. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 9 under 35 U.S.C. §112, first paragraph.



Regarding the rejection of claim 20, Applicants highlight that in discussing a method of forming the claimed “sealing member,” the written description states that the “sealing member” is initially formed by compressing a polyisoprene plug into a flat state. (See page 7, lines 34-36). The specification fails to provide any indication that the “sealing member” is adapted to retain fluid therein, is connectable to a source of fluid, or is otherwise inflatable in any manner, either in the written description or in the figures.

In view of the disclosure offered in the written description regarding the manufacture of the claimed "sealing member," and the absence of any indication that the "sealing member" is an inflatable structure, Applicants respectfully submit that one skilled in the art would understand that the claimed "sealing member" is "non inflatable," as recited in claim 20. Thus, Applicants respectfully submit that the recitation of a "sealing member" that is "non inflatable" is properly supported by the specification, and accordingly, respectfully request withdrawal of the rejection of claim 20 under 35 U.S.C. §112, first paragraph.

Claims 5-10, 22, 24-26, and 28-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,634,937 to Mollenauer, *et al.* (hereinafter "Mollenauer") in view of Stablein (DE 37 37 121 A1) (hereinafter "Stablein").<sup>1</sup> As mentioned above, Applicants have canceled claim 10 herein. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 10 under 35 U.S.C. §103(a) over the combination of Mollenauer and Stablein. With respect to the rejection of claims 5-9, Applicants respectfully submit that the combination of Mollenauer and Stablein fails to suggest the subject matter of these claims as a whole.

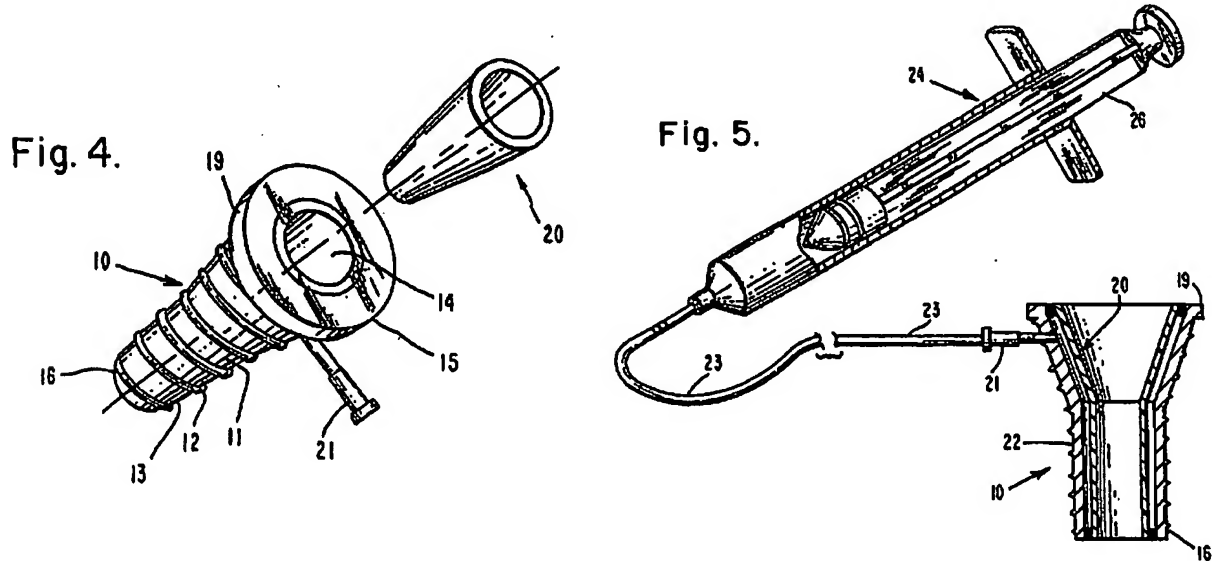
As amended, independent claim 5 recites "[a] cannula assembly for use in a surgical procedure" including, *inter alia*, "a housing," "a sealing member having proximal and distal faces disposed within the housing," and "a ring assembly positioned within the housing, the ring assembly including a first ring member and a second ring member positioned about the sealing member such that the sealing member is at least partially positioned between the first ring member and the second ring member." Amended independent claim 5 further recites that

---

<sup>1</sup> In an interview that was held with Applicants' representative, Michael Debono, on July 7, 2009, the Examiner clarified that the rejection under 35 U.S.C. §103(a) over the combination of Mollenauer and Stablein was only applicable to claims 5-10, and indicated that such would be reflected in a subsequently prepared interview summary.

“first ring member” is “configured and dimensioned for engagement with the second ring member to inhibit relative movement therebetween.”

Mollenauer relates to “the field of surgical endoscopy, specifically to improvements in skin seals and cannulas.” (Col. 1, lines 5-6). In one embodiment of the disclosure, Mollenauer describes a threaded skin seal 10 including a wall 22 defining an inner bore 14 that accommodates an inflatable balloon membrane 20. (See col. 5, lines 45-49; see col. 6, lines 9-11, 22-29; FIGS. 4, 5 below).



In the Final Office Action, the membrane 20 was characterized as the “sealing member” recited in the claims. (See Final Office Action, page 4). It was acknowledged, however, that Mollenauer fails to disclose a “sealing member” that includes “a fabric material,” as recited in amended independent claim 5 for example, and Stablein was relied upon for disclosure of this concept.

Even if it is assumed, *arguendo*, that the characterization of Stablein proffered in the Final Office Action is accurate, neither Mollenauer nor Stablein discloses, or even suggests,

any structure that could be reasonably interpreted as “a ring assembly positioned within the housing, the ring assembly including a first ring member and a second ring member positioned about the sealing member such that the sealing member is at least partially positioned between the first ring member and the second ring member,” as recited in amended independent claim 5.

Accordingly, for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Mollenauer and Stablein fails to suggest the subject matter of amended independent claim 5 as a whole, and therefore, that amended independent claim 5 is allowable over Mollenauer in view of Stablein under 35 U.S.C. §103(a). Since claims 6-9 depend either directly or indirectly from amended independent claim 5, and include each element recited therein, for at least the reasons that amended independent claim 5 is allowable over Mollenauer in view of Stablein under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claims 6-9 are also allowable over Mollenauer in view of Stablein under 35 U.S.C. §103(a).

Claims 11 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mollenauer in view of Stablein and U.S. Patent Number 5,463,010 to Hu, *et al.* (hereinafter “Hu”). Applicants respectfully submit, however, that the combination of Mollenauer, Stablein, and Hu fails to suggest the subject matter of claims 11 and 17 as a whole.

In the Final Office Action, it was acknowledged that the combination of Mollenauer and Stablein fails to disclose a “sealing member” that “includes a coating to reduce friction between the seal member and the at least one surgical instrument,” as recited in claim 11, and Hu was relied upon for disclosure of this concept. (*See* Final Office Action, pages 5-6).

As previously discussed, the combination of Mollenauer and Stablein fails to suggest the subject matter of amended independent claim 5 as a whole. Assuming, *arguendo*,

that the characterization of Hu proffered by the Examiner is accurate, incorporating the coating material purportedly disclosed therein would fail to remedy the deficiencies in the combination of Mollenauer and Stablein discussed above.

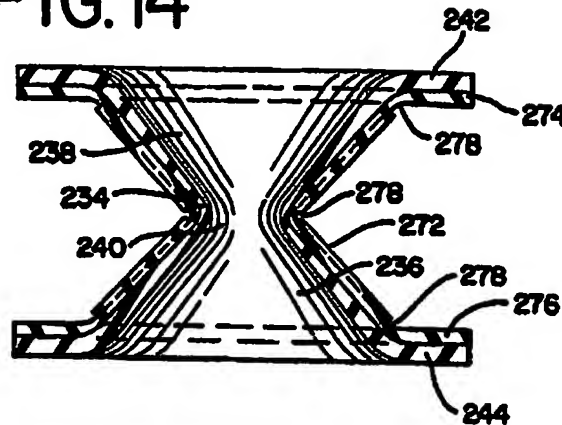
Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Mollenauer, Stablein, and Hu fails to suggest the subject matter of amended independent claim 5 as a whole, and therefore, that amended independent claim 5 is allowable over Mollenauer in view of Stablein and Hu under 35 U.S.C. §103(a). Since claims 11 and 17 depend directly and indirectly from amended independent claim 5, respectively, and include each element recited therein, for at least the reasons that amended independent claim 5 is allowable over Mollenauer in view of Stablein and Hu under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submits that claims 11 and 17 are also allowable over Mollenauer in view of Stablein and Hu under 35 U.S.C. §103(a).

Claims 5, 12, 13, 19, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,350,364 to Stephens, *et al.* (hereinafter "Stephens") in view of Stablein. As mentioned above, Applicants have canceled claims 12 and 19 herein. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 12 and 19 under 35 U.S.C. §103(a) over the combination of Stephens and Stablein. With respect to the rejection of claims 5, 13, and 20, Applicants respectfully submit that the combination of Stephens and Stablein fails to suggest the subject matter of these claims as a whole.

Stephens relates to "surgical instruments," and more particularly, "to trocar assembly devices for providing communication into an anatomical cavity." (Col. 1, lines 9-12). In one embodiment of the disclosure, Stephens describes a seal member 234 including an

hourglass configuration for use with a trocar assembly. (See col. 8, lines 17-21; FIG. 14 below).

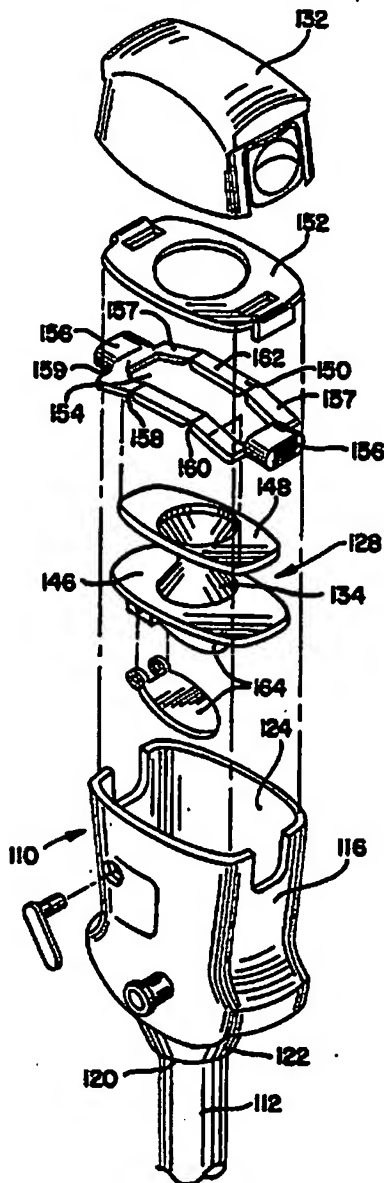
FIG. 14



In the Final Office Action, the seal member 234 was characterized as the “sealing member” recited in the claims. (See Final Office Action, page 6). It was acknowledged, however, that Stephens fails to disclose a “sealing member” that includes “a fabric material,” as recited in amended independent claim 5 for example, and Stablein was relied upon for disclosure of this concept.

Even if it is assumed, *arguendo*, that the characterization of Stablein proffered in the Final Office Action is accurate, neither Stephens nor Stablein discloses, or even suggest, any structure that could be reasonably interpreted as the “ring assembly” recited in amended independent claim 5. While Applicants note the disclosure in Stephens pertaining to top and bottom seal collars 148, 146, respectively, (see col. 6, line 61 – 64; FIG. 6 below), Applicants highlight that the top seal collar 148 does not engage the bottom seal collar 146 in any manner. In fact, Stephens discloses that the “[t]op seal collar 148 is positioned within housing 116 adjacent opening 126 in a manner that permits it to move or float toward and away from bottom seal collar 146.” (Col. 7, lines 1-4) (emphasis added).

FIG. 6



Thus, Applicants respectfully submit that neither Stephens, nor Stablein, nor any proper combination thereof, discloses or suggests, "a ring assembly positioned within the housing, the ring assembly including a first ring member and a second ring member positioned about the sealing member such that the sealing member is at least partially positioned between



the first ring member and the second ring member” wherein the “first ring member” is “configured and dimensioned for engagement with the second ring member to inhibit relative movement therebetween,” as recited in amended independent claim 5.

Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Stephens and Stablein fails to suggest the subject matter of amended independent claim 5 as a whole, and therefore, that amended independent claim 5 is allowable over Stephens in view of Stablein under 35 U.S.C. §103(a). Since claims 13 and 20 depend directly from amended independent claim 5, and include each element recited therein, for at least the reasons that amended independent claim 5 is allowable over Stephens in view of Stablein under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submits that claims 13 and 20 are also allowable over Stephens in view of Stablein under 35 U.S.C. §103(a).

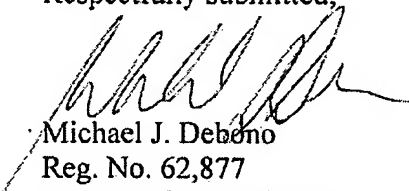
As mentioned above, Applicants have added new claims 21-31 for consideration. Since new claims 21-31 depend either directly or indirectly from amended independent claim 5, which is allowable in accordance with the foregoing discussion, for at least the reasons that amended independent claim 5 is allowable, *inter alia*, Applicants respectfully submit new claims 21-31 are also allowable.

In view of the foregoing remarks and arguments, Applicants respectfully submit that claims 5-9, 11, 13, 17, and 20-31 are allowable over the references of record. Accordingly, Applicants respectfully request allowance of these claims.

Should the Examiner feel that an interview may facilitate the resolution of any outstanding matters, the Examiner is sincerely invited to contact Applicants’ undersigned attorney at the number indicated below.

Please charge any deficiency, as well as any other fee(s) which may become due under 37 C.F.R. §1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required, and charge Deposit Account No. 21-0550 therefor.

Respectfully submitted,



Michael J. Debono  
Reg. No. 62,877  
Attorney for Applicants

***Carter, DeLuca, Farrell & Schmidt, LLP***  
445 Broad Hollow Road, Suite 420  
Melville, New York 11747  
Tel.: (631) 501-5700  
Fax: (631) 501-3526

**Send correspondence to:**  
Chief Patent Counsel  
Covidien  
60 Middletown Avenue  
North Haven, Connecticut 06473